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In re Application of :  
Maria Palasis :  
Serial No.: 09/542,935 : DECISION ON PETITION  
Filed: April 4, 2000 :  
Attorney Docket No.: 12013/56301 :

This letter is in response to the Petition under 37 C.F.R. 1.181, filed February 8, 2007, to grant priority to earlier filed SN 09/204,254 (now US 6,369,039).

#### BACKGROUND

A review of the recent file history of this application shows that the examiner mailed a non-Final Office action to applicant on March 6, 2006, addressing claims 60, 62 and 65-91. The examiner on page 2 of the action addressed the priority claim stating that applicant had not complied with one or more conditions for receiving benefit of priority for the claimed invention in the earlier application, specifically stating that all claims were not supported by the disclosure of the earlier application under 35 U.S.C. 112, first paragraph, for lack of written description, and set forth reasons therefore. A rejection was also made of the claims under 35 U.S.C. 112, first paragraph, for lack of written description. The claims were also rejected under 35 U.S.C. 103(a) over various references and combinations.

Applicants replied arguing the denial of priority on June 6, 2006, and addressed all other rejections appropriately. The examiner then mailed a Final Office action to applicants on August 15, 2006, maintaining the denial of priority and all of the other rejections of record for essentially the same reasons as previously set forth.

Applicants filed an amendment/argument directed solely to the issue of priority on November 14, 2006. The examiner mailed an Advisory action to applicants denying entry of the paper on December 8, 2006.

Applicants file this petition on February 8, 2007, followed by a Notice of Appeal on February 16, 2007.

## DISCUSSION

Applicants complain that the examiner has improperly denied them benefit of priority to an earlier application and request that the pending claims be granted priority to SN 09/204,254.

Inasmuch as the benefit of priority in this particular instance is intimately associated with a rejection under 35 U.S.C. 112, first paragraph, for lack of written description, such denial of benefit of priority must be appealed to the Board of Patent Appeals and Interferences (BPAI). It is noted that such has been done. It is recognized that applicant has filed a claim of benefit of priority to said prior application and such claim is recognized insofar as proper. What is (and has been done) by the examiner is to determine whether support for the instantly claimed invention can be found in such earlier application. If not then benefit of the earlier application's filing date cannot be granted to the instantly claimed invention. Such disputes are resolved only at the BPAI.

## DECISION

The petition is **DISMISSED** as moot in that it is not directed to a petitionable matter.

**Applicant remains under obligation to file an Appeal Brief within the time period provided, or as extended under 37 CFR 1.136(a).**

Any request for reconsideration of this decision must be filed within TWO MONTHS of the mailing date thereof in order to be considered timely.

Should there be any questions regarding this decision, please contact Special Program Examiner William R. Dixon, Jr., by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-0519 or by Official Fax at 571-273-8300



Christopher Low  
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